

I. Status of the claims

Claims 4, 5 and 7 have been canceled. Accordingly, claims 1-3, 6, and 8-10 are now pending. Claim 1 has been amended to recite that the emulsion is transparent and comprises from about 5 to about 15% w/w of an oily component; from about 85 to about 95% w/w of an aqueous phase and from about 0.05 to about 10% w/w of an emulsifier and that the oily component comprises from 5 – 12 % of one or more silicone waxes; from 0.5 – 2.5 % of one or more silicone oils; and optionally one or more suitable oils. Claim 1 has also been amended to recite that the aqueous phase comprises one or more polyols selected from ethylene glycol, propylene glycol, butylene glycol, pentylene glycol, hexylene glycol, glycerine, sorbitol, cyclohexanediol and mixtures thereof, that the emulsifier is selected from an ethoxylated or propoxylated fatty alcohol; that the viscosity of the emulsion is less than 100mPas measured with a plate/cone rotation rheometer at a constant shear rate of 500 s⁻¹ and that the polyol is present in the emulsion in an amount ranging from about 50 to about 98% w/w and is effective to adjust the refractive index of the aqueous phase so that it does not differ more than about 0.003 from the refractive index of the oily component. Support can be found in the Specification at least at page 4, lines 21-26; page 6, lines 13-15; page 10, lines 18-21; page 10, lines 23-30; and page 11, lines 1-4, lines 9-12 and lines 17-21. Claims 6, 8 and 9 have been amended to be consistent with the amendments to claim 1. Accordingly, no new matter has been introduced by this Amendment.

II. Claim Rejections – 35 U.S.C. § 112

The Examiner has rejected claim 5 for insufficient antecedent basis for the limitation “one or more silicone oils.” Applicants have canceled claim 5. Accordingly, Applicants request withdrawal of this rejection.

III. Claim Rejections - 35 U.S.C. § 103

A. The Examiner has rejected claims 1, 2 and 9-10 under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 6,013,682 (“Dalle et al.”). Applicants respectfully traverse this rejection.

As amended, claim 1 relates to a transparent sprayable oil-in-water emulsion comprising from about 5 to about 15% w/w of an oily component; from about 85 to about 95% w/w of an aqueous phase; and from about 0.05 to about 10% w/w of an emulsifier. The oily component comprises from 5 – 12 % of one or more silicone waxes; from 0.5 – 2.5 % of one or more silicone oils; and optionally one or more suitable oils. The aqueous phase comprises one or more polyols selected from ethylene glycol, propylene glycol, butylene glycol, pentylene glycol, hexylene glycol, glycerine, sorbitol, cyclohexanediol and mixtures thereof. The emulsifier is selected from an ethoxylated or propoxylated fatty alcohol. The viscosity of the emulsion is less than 100mPas measured with a plate/cone rotation rheometer at a constant shear rate of 500 s^{-1} . The polyol is present in the emulsion in an amount ranging from about 50 to about 98% w/w and is effective to adjust the refractive index of the aqueous phase so that it does not differ more than about 0.003 from the refractive index of the oily component. As discussed in the Specification, through the use of the oil-in-water emulsion having the components recited by the present claims, Applicants discovered that a transparent, sprayable cosmetic oil-in-water formulation that provides good miniaturization could be obtained. Such a cosmetic formulation is neither taught nor suggested by the prior art relied upon by the Examiner.

Dalle et al. relates to methods for making silicone in water emulsions comprising mixing (I) a composition containing at least one polysiloxane, at least one organosilicone material that reacts with the polysiloxane by a chain extension reaction and a metal catalyst for the reaction; (II) at least one surfactant; and (III) water to form a mixture which is then emulsified. There is no teaching or suggestion of the transparent sprayable oil-in-water emulsion recited by the present claims. In particular, there is no teaching or suggestion of the polyol recited by the present claims much less of a transparent oil-in-water emulsion wherein the refractive index of the aqueous phase does not differ more than about 0.003 from the refractive index of the oil phase. The Examiner argues that because Dalle et al. teaches the inclusion of nonionic surfactants Dalle et al. teaches a polyol. However, the nonionic surfactants recited by Dalle et al. are not the same as the polyols recited by the present claims and there is clearly no teaching or suggestion that a polyol should or could be included to adjust the refractive index of the aqueous phase. Further, there is no teaching or suggestion in Dalle et al. of an emulsifier selected from an ethoxylated or propoxylated fatty alcohol or

of silicone oils present in the emulsion recited by the present claims. Applicants also note that Dalle et al. fails to teach or suggest an oil-in-water emulsion having a viscosity of less than 100mPas measured with a plate/cone rotation rheometer at a constant shear rate of 500 s⁻¹. Accordingly, Dalle et al. fails to render the present claims obvious and the rejection should be withdrawn.

B. The Examiner has rejected claims 3-8 under 35 U.S.C. § 103 as unpatentable over Dalle et al. as applied to claims 1-2 and 9-10 and in further view of U.S. Patent No. 5,443,760 (“Kasprzak”). Applicants respectfully traverse this rejection.

The Examiner relies upon Kasprzak as teaching the inclusion of silicone oils and propylene glycol in oil-in-water emulsions. According to the Examiner, because Kasprzak teaches the inclusion of silicone oils in oil-in-water emulsions it would have been obvious to include silicone oils in the emulsions taught by Dalle et al. The Examiner argues that one would be motivated to do so “because the combined ingredients of silicone wax and silicone oils as the oily component of the oil-in-water emulsion would result in a complementary or possibly synergistic effect.” However, the Examiner has failed to provide support for this conclusion. There is nothing in the teachings of Kasprzak that would lead one of ordinary skill in the art with the expectation that a “complementary or synergist effect” would be obtained. Further, Kasprzak fails to cure the deficiencies of Dalle et al. discussed above. There is no teaching or suggestion of the transparent, sprayable oil-in-water emulsion having the properties recited by the present claims. Accordingly, Applicants respectfully request withdrawal of this rejection.

IV. Conclusion

For the reasons set forth above, Applicants respectfully request withdrawal of all outstanding objections and rejections. If the Examiner feels that a discussion with Applicants’ representative would be helpful in resolving the outstanding issues, the Examiner is invited to contact Applicants’ representative at the number provided below.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 10-0750/J&J5012USPCT/IPB. If a fee is

required for an Extension of time 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account No. 10-0750/J&J5012USPCT/JPB.

Respectfully submitted,

/James P. Barr/

James P. Barr
Reg. No. 32,882
Attorney for Applicant(s)

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-2826
DATE: June 16, 2009